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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,408	11/20/2003	Nobumasa Sasa	KON-1836	9984
20311	7590	04/24/2006	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/718,408

Applicant(s)

SASA, NOBUMASA

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3-8 and 10-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e). (See Attachment)
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 4/3/06 and 1.132 declaration filed 4/13/06 have been fully considered, however, the declaration has not been entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit is necessary and was not presented earlier. See 37 CFR 1.16(e).

Further, it is noted that even *if* the declaration were entered, the present claims would not be allowable over the "closest" prior art Roth (U.S. 5,889,084) for the following reasons.

Applicants 1.132 declaration compares composition comprising oxetane compound, i.e. 7,8-epoxy-2-oxa-5-methylspiro-[3.5]-nonane, epoxidized soybean oil, initiator, and colorant (Ink 23) with ink outside the scope of the present claims but within the scope of the "closest" prior art Roth, namely, (i) ink comprising epoxy compound, epoxidized soybean oil, initiator, and colorant (i.e. comprises no oxetane and epoxy compound outside scope of the present claims) (Ink 21), (ii) ink comprising epoxidized soybean oil, initiator, and colorant (i.e. comprises no oxetane) (Ink 22), or (iii) ink comprises epoxy compound, triethylene glycol divinyl ether, initiator, and colorant (i.e. comprises no oxetane and no epoxidized soybean oil) (Ink 2). It is shown that Ink 23 is superior in terms of storage stability and safety.

However, it is the examiner's position that the declaration *if* entered would not be successful in establishing unexpected or surprising results over the cited prior art given that the declaration is not commensurate in scope with the scope of the present invention.

For instance, applicant states on page 3 of the declaration filed 4/13/06 that Ink 23 is an inventive ink representative of the claimed invention. However, this ink utilizes oxetane

compound, i.e. 7,8-epoxy-2-oxa-5-methylspiro-[3.5]-nonane, which is outside the scope of the present invention. While present claim 1 recites “oxetane compound” and not specific type of oxetane, it is noted that claims are given their broadest interpretation consistent with the specification. As set forth in the present specification oxetane compound includes 3-ethyl-3-hydroxymethyl oxetane, 1,4-bis[(3-ethyl-3-oxetanyl) methoxymethyl] benzene, 3-ethyl-3-(phenoxymethyl) oxetane, di(1-ethyl-3-oxetanyl) methyl ether, and 3-ethyl-3-(2-ethylhexyloxymethyl) oxetane. The oxetane used in the declaration is not one of the oxetanes utilized in the present invention. It is significant to note that if applicants were to amend the present claims to recite that the oxetane is 7,8-epoxy-2-oxa-5-methylspiro-[3.5]-nonane, such recitation would be considered new matter. Thus, it is not clear that Ink 23 is an inventive example. Applicant’s attention is further drawn to claims 12 and 13. Given that each of these claims recites specific oxetane compounds, the declaration is clearly not commensurate in scope with the scope of claims 12 and 13 given that Ink 23 set forth in the declaration utilizes oxetane other than those recited in either of claim 12 or 13.

Further, the declaration is not persuasive given that the data is not commensurate in scope with the scope of the present claims given that the data only discloses composition using one amount. That is, the declaration utilizes ink that comprises 40% oxetane and 58% epoxidized soybean oil. However, there is no data utilizing lower or higher amounts of either of the oxetane or the epoxidized soybean oil which is significant given that, with the exception of present claims 5-6, the present claims are open to any amount of oxetane and epoxidized soybean oil. With respect to claim 5, it is noted that there is no data in the declaration of ink comprising

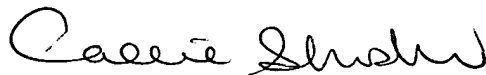
epoxidized soybean oil at the upper and lower end of the claimed amount. With respect to claim 6, it is noted that the amount of epoxidized soybean oil is in fact outside the scope of this claim.

Further, applicant points to Ink 22 that comprises 98 parts epoxidized soybean oil, initiator, and colorant and notes that this ink, which is within the scope of the "closest" prior art Roth, was not capable of curing. However, such results were determined using only one specific amount of epoxidized soybean oil. There is no data regarding ink comprising only epoxidized soybean oil but at different amounts. Additionally, there is not proper side-by-side comparison between Ink 23 and Ink 22 given that Ink 22 comprises much higher amount of epoxidized soybean oil. Thus, it is not clear if the differences between Ink 23 and Ink 22 are due to the presence (or absence) of oxetane or to the different amounts of epoxidized soybean oil utilized in the inks.

Thus, it is the examiner's position that even *if* the declaration were entered, the declaration would not be persuasive in overcoming the rejections of record.

It is noted that given that the declaration has not been entered for the reasons set forth above, the amendment filed 4/3/06 has also not been entered given that applicants response cannot be entered in part. However, if the amendment were submitted in a separate, timely filed amendment, it is noted the amendment would overcome the 35 USC 112 rejection of record.

CS
4/19/06


Callie E. Shosho
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Art Unit 1714